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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/964,858	09/28/2001	Margaret K. Hostetter	P07274US02/BAS	2374

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ALEXANDRIA, VA 22314

EXAMINER
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DEVI, SARVAMANGALA J N

ART UNIT	PAPER NUMBER
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1645

DATE MAILED: 01/03/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
**09/964,858**

Applicant(s)  
**Hostetter et al.**

Examiner  
**S. Devi, Ph.D.**

Art Unit  
**1645**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE one MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Feb 21, 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-30 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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### **Election/Restriction**

- 1) Claims 1-30 are under prosecution.
- 2) **Please Note:** In an effort to enhance communication with our customers and reduce processing time, Group 1640 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number is 703-308-4315. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. If you have any questions or suggestions please contact Paula Hutzell, Ph.D., Supervisory Patent Examiner at Paula.Hutzell@uspto.gov or 703-308-4310. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.
- 3) Restriction to one of the following inventions is required under 35 U.S.C. 121:
  1. Claims 2, 13 and 23, drawn to an antibody to the propeptide region at amino acids 1-263 of the Int1p protein, classified in class 530, subclass 388.5
  2. Claims 13 and 23, drawn to an antibody to the catalytic domain 1 at amino acids 435-639 of the Int1p protein, classified in class 530, subclass 388.5
  3. Claims 13 and 23, drawn to an antibody to the catalytic domain 2 at amino acids 738-949 of the Int1p protein, classified in class 530, subclass 388.5
  4. Claims 13 and 23, drawn to an antibody to the processing domain motif at amino acids 1022-1236 of the Int1p protein, classified in class 530, subclass 388.5
  5. Claims 1, 3, 4 and 9-11, drawn to an antibody against Int1p protein of *Candida albicans*, classified in class 530, subclass 387.9
  6. Claims 5-8, drawn to a method of preventing an infection comprising administering an antibody against Int1p protein of *Candida albicans*, classified in class 424, subclass 130.1
  7. Claim 16, drawn to a method of treating an infection by administering an antibody to a peptide, classified in class 424, subclass 139.1
  8. Claims 18 and 22, drawn to a propeptide region at amino acids 1-263 of the Int1p protein, classified in class 530, subclass 300

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9. Claims 18 and 22, drawn to a peptide at amino acids 435-639 of the Int1p protein, classified in class 530, subclass 300
10. Claims 18 and 22, drawn to a peptide at amino acids 738-949 of the Int1p protein, classified in class 530, subclass 300
11. Claims 18 and 22, drawn to a peptide at amino acids 1022-1236 of the Int1p protein, classified in class 530, subclass 300
12. Claim 19, drawn to a method of generating an antibody using the propeptide region at amino acids 1-263 of the Int1p protein, classified in class 436, subclass 547
13. Claim 19, drawn to a method of generating an antibody using the peptide at amino acids 435-639 of the Int1p protein, classified in class 436, subclass 547
14. Claim 19, drawn to a method of generating an antibody using the peptide at amino acids 738-949 of the Int1p protein, classified in class 436, subclass 547
15. Claim 19, drawn to a method of generating an antibody using the peptide at amino acids 1022-1236 of the Int1p protein, classified in class 436, subclass 547
16. Claim 20, drawn to a nucleic acid sequence coding for the propeptide region at amino acids 1-263 of the Int1p protein, classified in class 536, subclass 23.74
17. Claim 20, drawn to a nucleic acid sequence coding for the peptide at amino acids 435-639 of the Int1p protein, classified in class 536, subclass 23.74
18. Claim 20, drawn to a nucleic acid sequence encoding the peptide at amino acids 738-949 of the Int1p protein, classified in class 536, subclass 23.74
19. Claim 20, drawn to a nucleic acid sequence encoding the peptide at amino acids 1022-1236 of the Int1p protein, classified in class 536, subclass 23.74
20. Claim 21, drawn to a method of inducing an immunological response by administering a propeptide region at amino acids 1-263 of the Int1p protein, classified in class 424, subclass 274.1
21. Claim 21, drawn to a method of inducing an immunological response by

- administering a peptide region at amino acids 435-639 of the Int1p protein, classified in class 424, subclass 274.1
22. Claim 21, drawn to a method of inducing an immunological response by administering a peptide region at amino acids 738-949 of the Int1p protein, classified in class 424, subclass 274.1
  23. Claim 21, drawn to a method of inducing an immunological response by administering a peptide region at amino acids 1022-1236 of the Int1p protein, classified in class 424, subclass 274.1
  24. Claims 24 and 25, drawn to a method of diagnosing an infection using an antibody against a peptide of the Int1p protein, classified in class 435, subclass 7.1
  25. Claims 28-30, drawn to a method of treating infections by administering an agent that modulates a propeptide at amino acids 1-263 of the Int1p protein, classified in class 514, subclass 2
  26. Claims 28-30, drawn to a method of treating infections by administering an agent that modulates a peptide at amino acids 435-639 of the Int1p protein, classified in class 514, subclass 2
  27. Claims 28-30, drawn to a method of treating infections by administering an agent that modulates a peptide at amino acids 738-949 of the Int1p protein, classified in class 514, subclass 2
  28. Claims 28-30, drawn to a method of treating infections by administering an agent that modulates a peptide at amino acids 1022-1236 of the Int1p protein, classified in class 514, subclass 2

Claims 12, 14, 15 and 17 are considered as linking claims and would be joined with one of inventions 1 through 4, if elected.

Claims 26 and 27 are considered as linking claims and would be joined with one of inventions 25-28, if elected.

4) Inventions 1-28 are distinct from one another. Inventions 1-5, 8-11 and 16-19 are directed to distinct products: antibodies to specific peptides; various peptides and various nucleic

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acids, which differ from one another structurally and biologically and/or immunogenically. Although the antibodies, peptides and nucleic acids of these inventions belong to the same class/subclass, each peptide or nucleic acid is distinct from the other in its structural composition, each requiring a separate sequence search. A sequence search performed for one peptide or nucleic acid would not be co-extensive to the other. Inventions 6, 7, 12-15 and 20-28 are drawn to distinct methods which differ from one another in methods steps and parameters, the composition(s) or reagents used and the ultimate goals accomplished.

5) Inventions 5 and 6, inventions 8 and 20, inventions 9 and 21, inventions 10 and 22, inventions 11 and 23, inventions 5 and 24, inventions 1 and 25, inventions 2 and 26, inventions 3 and 27, and inventions 4 and 28, are related as product and process of using the product. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process of using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P 806.05(h)). In the instant case, the antibody and the peptide can be used in a materially different process, for example, as an immunogen to produce anti-idiotypic antibodies and as a coating antigen in an *in vitro* diagnostic assay, respectively.

6) Inventions 1 and 12, inventions 2 and 13, inventions 3 and 14, and inventions 4 and 15 are related as product and process of making the product. The inventions are distinct if either or both of the following can be shown: (1) that the processes as claimed can be used to make other and materially different products or (2) that the products as claimed can be made by another and materially different processes (MPEP 806.05(f)). In the instant case, the antibody product can be made by a materially different without using the recited peptide, for example, by chemical synthesis.

Because these inventions are distinct for the reasons given and have acquired a separate status in the art as shown by their different classifications/subclassifications and divergent subject matter, and since a search performed for one product would not be co-extensive to the other, restriction for examination purposes as indicated is proper.

7) Applicants are advised that the response to this requirement to be complete must include

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an election of the invention to be examined even though the requirement be traversed (37 C.F.R. 1.143).

8) Applicants are reminded that upon cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filled petition under C.F.R. 1.48(b) and by the fee required under 37 C.F.R. 1.17(h).

9) Any inquiry concerning this communication or earlier communications from the Examiner should be directed to S. Devi, Ph.D., whose telephone number is (703) 308-9347. A message may be left on the Examiner's voice mail system. The Examiner can normally be reached on Monday to Friday from 7.15 a.m. to 4.15 p.m. except one day each bi-week which would be disclosed on the Examiner's voice mail system.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Lynette Smith, can be reached on (703) 308-3909.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

January, 2003

  
S. DEVI, PH.D.  
PRIMARY EXAMINER



# RESTRICTION ELECTION FACSIMILE TRANSMISSION

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